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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,501	03/31/2004	Peter Siepen	10191/3614	6467
26646 7590 10/27/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER SHEER, CRISTINA O				
ART UNIT 3685		PAPER NUMBER		
MAIL DATE 10/27/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,501

Applicant(s)

SIEPEN ET AL.

Examiner

CRISTINA OWEN SHERR

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 1018 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This Office Action is in response to Applicant's amendment filed June 9, 2008. Claim 9 is currently canceled. Claims 1, 10, 11, 12, and 13 are currently amended. Claims 1-8 and 10-18 are currently pending in this case. Claims 1-8, 10-14, and 17-18 are currently under examination.

Response to Arguments

2. Applicant's arguments with respect to the section 112 rejections of claim 5 filed June 9, 2008 have been fully considered but they are not persuasive.
3. Applicant argues that the claims are made clear in the specification. We note that in the specification, the storage medium for the data is, in fact, inside the vehicle. Nevertheless, the claims do not specify the said location of the storage medium for the data.
4. We note that applicant makes not arguments regarding the section 112 rejection of claims 1-4, 6-8, 10-14, and 17-18, yet concludes those rejections should be withdrawn. The 112 rejections are upheld with respect to all the claims.
5. Applicant's arguments, filed June 9, 2008, with respect to the section 102 rejections of the claims, as currently amended, have been fully considered and are persuasive. The section 102 rejection of 1-8, 10-14, and 17-18 has been withdrawn. Applicant's arguments filed June 9, 2008 with respect to the section 103 rejection of claims 1-8, 10-14, and 17-18 have been fully considered but they are not persuasive. Applicant's sole argument with respect to the section 103 rejections is that it would not be obvious to a person having ordinary skill in the art at the

time the invention was made to mount, place or locate the system, apparatus or device of Takeuchi inside the vehicle such as on the dashboard or even in the trunk, rather than outside the vehicle such as on the hood. In essence, Applicant challenges Official Notice. We offer the following reference in response to the challenge to Official Notice. The motivation for this would be a desire to prevent theft of the said device. We note that is old is and well-known to place all sorts of devices inside a vehicle in order to prevent theft. Examples of these are car radios, car stereos, radar detecting devices (which, although often illegal, are nonetheless common). Note, for example, the history of police radio equipment in "CHP Two Way Radio Systems" (Geoff Fors, Monterey California, copyright June 22, 2000, at <http://www.mbay.net/~wb6nvh/chpradio.htm>), describing radios inside cars as early as the 1960's.

6. We further note that is old and well-known to want to prevent theft. Thus such motivation is clearly old and well-known.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112: The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-14, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Independent claims 1 and 17 make reference to a system or method for "outputting useful data in a vehicle". This phrase is ambiguous as to whether the system or device is inside the vehicle or the data is inside the vehicle.
9. For these reasons, independent claims 1 and 17 and their dependent claims 2-14 and 18 are rejected under 35 U.S.C. 112.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-8, 10-14, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al (US 7,212,989).
12. Regarding claim 1 -
13. Taniguchi discloses a method for outputting protected useful data in a vehicle (e.g. abs), the method comprising: granting a usage authorization of the data in the vehicle as a function of one of a road traveled and an area traveled (e.g. col 8 ln 30-47); further comprising checking in a rights analysis unit, which is coupled to a playback unit, whether a usage right exists for the useful data to be played back. (e.g. col 11 ln 1-3).

14. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to mount , place or locate the system, apparatus or device of Takeuchi inside the vehicle such as on the dashboard or even in the trunk, rather than outside the vehicle such as on the hood. The motivation for this would be a desire to prevent theft of the said device.

15. Regarding claim 2 –

16. Taniguchi discloses a method as in claim 1, wherein the data is encrypted data (e.g. col 7 ln 55-60).

17. Regarding claim 3 –

18. Taniguchi discloses a method according to claim 1, further comprising transmitting the useful data via a radio signal into the vehicle (e.g. col 7 ln 62-67).

19. Regarding claim 4 –

20. Taniguchi discloses a method according to claim 1, further comprising providing the useful data on a storage medium in the vehicle. (e.g. col 2 ln 47-57).

21. Regarding claim 5 –

22. Taniguchi discloses a method according to claim 1, further comprising transmitting the usage authorization via a radio signal into the vehicle. (e.g. col 7 ln 32-40).

23. Regarding claim 6 –

24. Taniguchi discloses a method according to claim 1, further comprising providing the usage authorization on a storage medium in the vehicle.(e.g. col 2 ln 47-58).

25. Regarding claim 8 –

26. Taniguchi discloses a method according to claim 1, further comprising determining using a navigation system whether the vehicle is located inside the area for which a usage authorization was granted. (e.g. col 4 ln 19-34).
27. Regarding claim 10 –
28. Taniguchi discloses a method according to claim 9, further comprising decrypting the useful data in the rights analysis unit. (e.g. col 9 ln 30-47).
29. Regarding claim 11 –
30. Taniguchi discloses a method according to claim 9, further comprising: transmitting a decoding key from the rights analysis unit to the playback unit; and decrypting the useful data in the playback unit using the decoding key. (e.g. col 9 ln 30-47).
31. Regarding claim 12 –
32. Taniguchi discloses a method according to claim 9, further comprising granting the usage right with a time restriction. (e.g. col 9 ln 30-47).
33. Regarding claim 13 –
34. Taniguchi discloses a method according to claim 9, further comprising granting the usage right for a specific road type. (e.g. col 9 ln 30-47).1
35. Regarding claim 14 –
36. Taniguchi discloses a method according to claim 13, wherein the usage right is granted for toll roads of an operating company (e.g. col 22 ln 57-67).
37. Regarding claim 17-18 –
38. Claims 17-18 are rejected under the same criteria as above.

39. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.
40. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

41. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
42. Hoshino et al (US 6,088,680) discloses automatic toll adjusting system, and storage medium with a radio communication function, frequency converting apparatus, writing apparatus, settling apparatus, depositing apparatus and inquiring apparatus therefor.
43. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
44. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

45. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA OWEN SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Cristina Owen Sherr
Patent Examiner, AU 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685